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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,010	02/09/2001	Gordon James Smith	ROC920000267US1	6426

7590 07/17/2006

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EXAMINER	
NGUYEN, TAN D	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/781,010	SMITH, GORDON JAMES	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-9 and 21-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-9 and 21-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendments & Claims Status

The amendment of 4/21/06 has been entered. Claims 1-5, 7-9, 21-27, 28-31 are active and are rejected as followed. Claims 6, 20-30 have been canceled.

Response to Arguments

Applicant's arguments of 4/21/06 with respect to the 103 rejections of claims 1-9, 21-31 have been reviewed but these are not found persuasive.

Applicant's comment that Interlotto teaches the giving of a portion of the "net profits" of the gaming organization and not the player's payout is not persuasive because at the last 3 lines of the abstract, Interlotto shows the phrase "a portion of each prize pool is donated to charitable causes, which players select ...on the web site" which indicates that it's the player's prize which is pooled together and then pooled together with other player's prize to be sent to the charity organization which the player selects. Moreover, Jaffe also discloses the concept of "winning prizes in exchange for a pledge of donation" which fairly teaches the donation of a portion of the winning prize (gaming outcome) to charity in exchange for increasing one's chance for winning the prize. Therefore, in view of the teachings of Interlotte, Jaffe and Molbak above, the steps (a)-(e) are taught with at least a portion of the player's prize (gaming outcome) is sent to charity based on a pledge of donation to charity if winning the prize by the player in advance.

Applicant's comment that Molbak's has nothing to do with gaming is noted; however, Molbak is merely cited to teach the concept of presenting the potential donor

with a number of different options for donation in a donation transaction method and system as cited bellow. The teachings of the gaming and donation are cited in Interlotto and Jaffe.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 112

1. The rejections of claims 1-9 under 35 U.S.C. 112, second paragraph, have been withdrawn due to applicant's amendment of 4/21/06.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-5, 7-9 are rejected under 35 U.S.C. 103(a) as being obvious over (1) INTERLOTTO Article (Article "InterLotto..Lottery) in view of (2) Jaffe's Article ("Beware Charity Season Scams") (hereafter as "JAFFE") and (3) MOLBAK et al (US Patent 5,909,794).

As for independent claim 1, INTERLOTTO discloses a method for automating contributions in a gaming system comprising:

(a) introducing a user to a gaming option at an automated gaming system (web site of a web gaming system with offering of "Alpine Cash" game along with 6 to 40 games weekly);

(b) enabling the user to make a contribution to an organization;

(c) permitting the user to make a wager and partake the game in said system, said system determining a result using the wager;

(d) automatically presenting the game result (prize) to the user/player from the gaming website system; and

(e) automatically making a contribution to the charity organization based on the gaming result (prize) {see abstract}.

Note that the game system is carried out completely on the Internet system, therefore, the contribution step is carried out automatically. Interlotto teaches that the player select the charitable causes which indicate that a part of the "winning prize pool" belongs to the player as the player has the right to select his/her own cause for donation. In other word, Interlotto fairly discloses that a part of the player's winning prize (or outcome) is pooled with other winning prizes and automatically contributed to the charity organization selected by the player.

As for the new amended term of "outcome" instead of result, this is considered as the "prize" or inherently included in the "prize pool" portion belonged to or won by the player. Alternatively, the use of other equivalent term to indicate the winning prize by the player, result or outcome, etc., would have been obvious to a skilled artisan as mere using similar term for the same result. Therefore, Interlotto fairly teaches

the claimed invention except for step (b) and carrying out steps (c.), (d) and (e) based on the pledge of step (b).

In a case dealing with charity and gaming management, JAFFE Article discloses the teaching of an entity (organization, such as charity organization) holding a lottery game (game of chance) with the promise to the customer of a chance to win prizes (or payout) in exchange for a donation (pledge) {see page 2, about middle paragraph}. In other word, Jaffe discloses the use of a conditional agreement of pledging to make a contribution to charity in exchange for increasing one's chance of winning the lottery (or having a payout). Therefore, it would have been obvious to modify the teaching of Interlotto by enabling the player to make a pledge for a contribution to charity as mentioned by JAFFE Article if this would increase the chance of winning the prize (payout) as taught by Jaffe above and wherein making money or having a payout (winning the lottery) is more important than the noble feeling "joy of charity is in the giving, not in winning the prize".

In a similar donation transaction method and apparatus, MOLBAK et al is cited to teach the concept of presenting the potential donor with a number of different options for donation comprising:

(a) prompting a user with an option (choice) in a automated transaction system;

(b) enabling the user to pledge a contribution (to donate) to an organization at the beginning of the operation, and

(e) automatically making a contribution/donation to the selected charitable organization {see Fig. 4, 406, 408, 414, 424, 426, 436, 442-468, or col. 11, lines 49-56}.

It would have been obvious to modify the teachings of INTERLOTTO Article /JAFFE by including additional limitations in steps (a) and (b) for the benefit of providing (prompting) the potential donor an option (choice) for making a pledge of contribution to an organization as shown by MOLBAK et al above. Alternatively, by giving the user an option/choice to pledge donation or not to donate as taught by MOLBAK et al, this would make the gaming system of INTERLOTTO Article /JAFFE appears to be more legitimate as indicated by JAFFE above.

As for dep. claim 2 (part of 1), which deals with well known fundraising parameters, selection of the type of organization, this is non-essential to the scope of the claimed invention and would have been obvious to a fundraiser marketer as mere giving the donor choice for selection of his/her desired organization. Moreover, this is fairly taught in INTERLOTTO (last paragraph "players select...) or MOLBAK et al Fig. 4 (426).

As for dep. claim 3 (part of 1), which deals with well known fundraising parameters, selection of the size/amount of contribution, this is non-essential to the scope of the claimed invention and would have been obvious to a fundraiser marketer as mere giving the donor choice for selection of his/her desired contribution or odds/chance for winning the prize as taught by JAFFE or MOLBAK et al col. 11, lines 38-67}. It's logical that his/her chance of winning would vary directly with the size of the contribution or donation.

As for dep. claim 4 (part of 1), which discloses 2 odds of winning (payout) which are: (1) based on (a) and (2) based on pledge or (b), the 1st odd of winning is taught in

INTERLOTTO Article alone and the 2nd odd of winning is based on INTERLOTTO Article in view of JAFFE Article. Moreover, as indicated above, it's logical that the chance of winning would vary directly with the size of the contribution/donation. In view of the teaching of MOLBAK et al for presenting the user with different options, it would have been obvious to determine several options for odds of winning based on the pledge of contribution and presenting these options to the user.

As for dep. claim 5 (part of 1), this is rejected for the same reason set forth in the 1st part of dep. claim 4 above.

As for dep. claim 7 (part of 1), the limitation of "1st payout" is the same as "1st winning" and similarly for 2nd payout or 2nd winning and are shown in dep. claims 4-5 and are rejected for the same reason as in dep. claims 4-5 above.

As for dep. claim 8 (part of 1), this is taught on 2nd paragraphs "all winnings are forwarded immediately into player's InterLotto accounts" which indicates the accumulating of the winnings and contributions during a series of gaming activities.

As for dep. claim 9 (part of 1), which deals with well known fundraising parameters or practice, providing the information of gaming option and contribution (reporting) to the IRS, it would have been obvious to a fundraiser marketer to carry out this step so the IRS can properly verify the tax deductible amount by the user when filing his/her tax return. This is fairly taught in MOLBAK et al on Fig. 5, 583, 590.

4. Dep. claims 4, 5, 7 are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over INTERLOTTO / JAFFE Article /MOLBAK et al as applied to claims 1-9 above, and further in view of TORANGO (US 2003/00600279).

As for dep. claims 4, 5, 7, the teachings of INTERLOTTO / JAFFE Article / MOLBAK et al is cited above. TORANGO is cited to show well known teaching in the gaming art which is as the participant contributes more to the game prize, the odds of winning the prize becomes smaller, giving the participant a better chance at winning the prize {see Fig. 7, [0102]}. In other word, as % of contribution goes up, the odds or winning becomes smaller or the chance of winning goes up or % winning is direct proportional to the % of contribution of game prize (i.e. investing 50$ by buying 2 lottery tickets at $25.00/ticket has more chances of winning the prize than investing only $25 by buying 1 lottery ticket at $25.00/ticket). The total contribution to the game or the total cost to the player can be in the form of the buying more tickets or portion or giving more to charity or donation in this case. Therefore, it would have been obvious to modify the gaming step of INTERLOTTO/JAFFE Article /MOLBAK et al by tying the winning percentage to the level of contribution to charities (or overriding the 1st incentive with a 2nd incentive selected from the group consisting of a 2nd odds of winning and a 2nd payout, wherein the 2nd incentive is greater than the 1st incentive) as taught by TORANGO to encourage increase the level of contribution to charities and chances for winning.

5. Dep. claim 9 is rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over INTERLOTTO / JAFFE Article /MOLBAK et al as applied to claims 1-5, 7-8 above, and further in view of ZIARNO (US 6,253,998).

As for dep. claim 9 (part of 1), the teaching of INTERLOTTO/JAFFE Article /MOLBAK et al is cited above. In another fundraising process, ZIARNO is cited to teach the use of a receipt generator (820) to mail or fax or send/forward multiple copies of the contribution to the contributor or attender or other agency for tax purposes since the contribution to charities is normally tax deductible (Fig. 15a, col. 9, lines 5-47). ZIARNO mentions that format can be accepted by the IRS which inherently monitor individual tax related issues or return. Therefore, it would have been obvious to modify the process of INTERLOTTO/JAFFE Article /MOLBAK et al by automatically providing the information regarding the gaming option and the contribution the IRS as taught by ZIARNO to monitor tax related information if desired. Since everything in INTERLOTTO is done on the Internet, this step can be carried out automatically along with other functions.

6. Claims 21-27 (Apparatus), 28-30 (program product) are rejected under 35 U.S.C. 103(a) as being obvious over INTERLOTTO /JAFFE Article / MOLBAK et al.

As for Independent Apparatus claim 21, which deals with the apparatus to carry out the independent method claim 1 above, it's rejected over the system of INTERLOTTO Article in view of JAFFE Article and MOLBAK et al to carry out the method steps of claim 1 as cited in claim 1 above. Alternatively, the set up of an equivalent apparatus to carry out the steps of method claim 1 would have been obvious to a skilled artisan.

As for dep. claim 22 (part of 21 above), the interactive feature is inherently included in the teaching of INTERLOTTO Article which discloses a web site and the user has the ability to input/enter selection variables. Moreover, this is fairly taught in MOLBAK et al Fig. 4, 408, 424, 426, etc.

As for dep. claim 23 (part of 21 above), this limitation of "determining the result based on a random process" is inherently included in the lottery game of INTERLOTTO Article/JAFFE /MOLBAK et al since lottery is normally a game of chance and depends on a random process.

As for dep. claim 24 (part of 21 above), this is fairly taught in the teachings of INTERLOTTO Article/JAFFE Article /MOLBAK et al wherein a favorable result probability to the user is formed if he makes a promise/pledge of contribution of a portion of winning prize to charities.

As for dep. claim 25 (part of 21 above), which has similar limitation as in dep. claim 2 above, it's rejected for the same reason set forth in dep. claim 2 above.

As for dep. claim 26 (part of 21 above), which has similar limitation as in dep. claim 9 above, it's rejected for the same reason set forth in dep. claim 9 above.

As for dep. claim 27 which talks about the user device comprises an interactive visual display terminal, the interactive feature is inherently included in the teaching of INTERLOTTO Article which discloses a web site and the user has the ability to input/enter selection variables. This is also shown in MOLBAK et al Fig. 6A (250), 6B (1218).

As for Independent product claim 28 which discloses a program product for use in an automatic gaming apparatus and the processor to carry out the same steps as in Independent method claim 1 or apparatus claim 21 above, it's rejected over the program product to carry out the Internet-based lottery method /system of INTERLOTTO / JAFFE Article and MOLBAK et al.

As for dep. claims 29-30 which have the same limitation as in dep. claims 22-24, they are rejected for the same reasons set forth in claims 22-24 above.

7. Dep. claims 26, 31 are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over INTERLOTTO / JAFFE Article /MOLBAK et al as applied to claims 21-25, 27 and 28-30 respectively above, and further in view of ZIARNO (US 6,253,998).

As for dep. claims 26, 31(part of 21 and 28 respectively), the teaching of INTERLOTTO/JAFFE Article /MOLBAK et al is cited above. In another fundraising process, ZIARNO is cited to teach the use of a receipt generator (820) to mail or fax or send/forward multiple copies of the contribution to the contributor or attender or other agency for tax purposes since the contribution to charities is normally tax deductible (Fig. 15a, col. 9, lines 5-47). ZIARNO mentions that format can be accepted by the IRS which inherently monitor individual tax related issues or return. Therefore, it would have been obvious to modify the process of INTERLOTTO/JAFFE Article /MOLBAK et al by automatically providing the information regarding the gaming option and the contribution the IRS as taught by ZIARNO to monitor tax related information if desired. Since

everything in INTERLOTTO is done on the Internet, this step can be carried out automatically along with other functions.

Conclusions

THIS ACTION IS MADE FINAL. See MPEP 706.07 (a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

No claims are allowed.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct@uspto.gov. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean Nguyen/
Primary Examiner
July 10, 2006

July 2006